REMARKS

Applicants submit this preliminary amendment for the Examiner to consider new claims 20-74.

This application is a continuation of application serial no. 08/524,381. Claims 1-19 of this application were allowed by the Examiner in the parent application on a first office action. However, the Applicants withdrew the parent application from issue and filed the present application to permit the Examiner to consider the reference reported in the Information Disclosure Statement filed November 13, 1997.

Paragraph 2 of the Examiner's Statement of Reasons for Allowance in the parent application is not particularly clear. If the Examiner simply meant for paragraph 2 to reflect the differences between the Applicant's claimed invention and prior art of record, which is more clearly stated in paragraph 3, then the record may not require clarification.

If, however, the Examiner intended to comment in paragraph 2 on the scope of the allowed claims, Applicants respectfully submit that the Examiner made a number of legally incorrect comments. For example, the examiner used language that could suggest the scope of the allowed claims 1-19 was limited by implementation details included in the written description (*e.g.*, "The prior art fails to teach or suggest the claimed method and system with the explicitly recited *and inherently required combination of computer structure with its inherent and specific required software features as claim elements are found disclosed and supported in applicants' specification* ...."; "As the claim elements are found supported and defined by the

LAW OFFICES
FINNEGAN, HENDERSON,
FARABOW, GARRETT,
& DUNNER, L.L.P.
1300 I STREET, N.W.
WASHINGTON, DC 20005
202-408-4000

disclosure and *the claim breadth limited thereby* they are drawn to a unique special purpose computer ...."). Such a suggestion is contrary to precedent.

The language of the claim defines the scope of the protected invention. *Bell Communication Research, Inc. v. Vitalink Communications Corp.*, 55 F.3d 615, 619 (Fed. Cir. 1995); *see also York Prods., Inc. v. Central Tractor Farm & Family Ctr.*, 99 F.3d 1568, 1572 (Fed. Cir. 1996). Claims are to be given their "broadest reasonable interpretation" during prosecution. *See In re Donaldson*, 16 F.3d 1189 (Fed. Cir. 1994); *In re Prater*, 415 F.2d 1393, 1404-05 (C.C.P.A. 1969). And it is impermissible to impute limitations from the written description into a claim. *See E.I. Du Pont de Nemours & Co. v. Phillips Petroleum Co.*, 849 F.2d 1430, 1433 (Fed.Cir.1988). Accordingly, Applicants submit that the Examiner's suggestion that the scope of the allowed claims is limited by details in the written description is legally incorrect.

Additionally, the Guidelines for examining software-related inventions do not contain a directive inconsistent with the requirement that all claims are to be given their broadest reasonable interpretation for purposes of determining patentability. Examiners are required under the Guidelines to review the written description for purposes of determining whether the application discloses an invention that complies with 35 U.S.C. § 101 (i.e., statutory subject matter) and for understanding the claimed invention for purposes of determining its patentability under 35 U.S.C. §§ 102 and 103 (i.e., novelty and nonobviousness). This process does not, however, involve importing aspects of the written description into the claims for determining compliance with any one of sections 101, 102, and 103.

LAW OFFICES
FINNEGAN, HENDERSON,
FARABOW, GARRETT,
& DUNNER, L.L.P.
1300 I STREET, N. W.
WASHINGTON, DC 20005
202-408-4000

In any event, Applicants note that the Examiner's comments in the Statement of Reasons for Allowance have no application or relevance to the new claims added in this continuation application.

Applicants respectfully request examination and the timely allowance of pending claims 1-74.

The Commissioner is hereby authorized to charge any fees which may be required including fees due under 37 C.F.R. § 1.16 and any other fees due under 37 C.F.R. § 1.17, or credit any overpayment during the pendency of this application, to Deposit Account No. 06-0916.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,
GARRETT & DUNNER, L.L.P.

By: _____
Jeffrey A. Berkowitz
Reg. No. 36,743

Dated: July 21, 1998

LAW OFFICES
FINNEGAN, HENDERSON,
FARABOW, GARRETT,
& DUNNER, L.L.P.
1300 I STREET, N. W.
WASHINGTON, DC 20005
202-408-4000